

10-26-1998

FORM PTO-1619A
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U.S. Department of Commerce
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TO: The Commissioner of Patents and Trademarks: Please record the attached original document(s) or copy(ies).

Submission Type

New



Resubmission (Non-Recordation)

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Correction of PTO Error

Reel #

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Corrective Document

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Conveyance Type

Assignment



Security Agreement



License



Change of Name



Merger



Other

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Departmental File



Secret File

Conveying Party(ies)

Mark if additional names of conveying parties attached

Name (line 1)

Visa International Service Association

Execution Date
Month Day Year

5/29/98

Name (line 2)

Second Party

Name (line 1)

Execution Date
Month Day Year

Name (line 2)

Receiving Party

Mark if additional names of receiving parties attached

Name (line 1)

SET Secure Electronic Transaction LLC

If document to be recorded
is an assignment and the
receiving party is not
domiciled in the United
States, an appointment
of a domestic
representative is attached.
(Designation must be a
separate document from
Assignment.)

Name (line 2)

a corporation of Delaware

Address (line 1)

11885 Lackland Road, Suite 300

Address (line 2)

Address (line 3)

St. Louis

City

Missouri, USA

State/Country

63146-4236

Zip Code

Domestic Representative Name and Address

Enter for the first Receiving Party only.

Name

Address (line 1)

Address (line 2)

Address (line 3)

Address (line 4)

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Mail documents to be recorded with required cover sheet(s) information to:
Commissioner of Patents and Trademarks, Box Assignments, Washington, D.C. 20231**PATENT**
REEL: 9516 FRAME: 0996

Correspondent Name and Address

Area Code and Telephone Number **650-432-7005**

Name **Kurt M. Maschoff**

Address (line 1) **Visa International Service Association**

Address (line 2) **900 Metro Center Boulevard, MS M1-11A**

Address (line 3) **Foster City, CA 94404**

Address (line 4)

Pages

Enter the total number of pages of the attached conveyance document including any attachments.

3

Application Number(s) or Patent Number(s)

☐ Mark if additional numbers attached

Enter either the Patent Application Number or the Patent Number (DO NOT ENTER BOTH numbers for the same property).

Patent Application Number(s)

09/021,235

Patent Number(s)

5,761,306

If this document is being filed together with a new Patent Application, enter the date the patent application was signed by the first named executing inventor.

Month Day Year

Patent Cooperation Treaty (PCT)

Enter PCT application number

only if a U.S. Application Number has not been assigned.

PCT

PCT

PCT

PCT

PCT

PCT

Number of Properties

Enter the total number of properties involved.

2

Fee Amount

Fee Amount for Properties Listed (37 CFR 3.41): \$ **80.00**

Method of Payment:
Deposit Account

Enclosed ☐

Deposit Account ☒

(Enter for payment by deposit account or if additional fees can be charged to the account.)

Deposit Account Number:

22-0380

Authorization to charge additional fees:

Yes

☒

No

☐

Statement and Signature

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document. Charges to deposit account are authorized, as indicated herein.

Kurt M. Maschoff

Name of Person Signing

Signature

Date

Oct, 12 1998

EXCLUSIVE LICENSE

This agreement is made on May 29 1998 between:

- (1) Visa International Service Association, a corporation organized and existing under the laws of the State of Delaware, having an office and place of business at 900 Metro Center Boulevard, Foster City, California 94404, hereinafter referred to as "Visa"; and
- (2) SET Secure Electronic Transaction LLC, a company organized under the laws of Delaware, with a principal place of business located at 11885 Lackland Road, Suite 300, St. Louis, Missouri 63146-4236 ("SETCo"), U.S.A., hereinafter referred to as "SET Co."

WHEREAS:

- (a) Visa is the owner, by assignment (executed May 3, 1996 and recorded in the United States Patent and Trademark Office at Reel 7937, Frame 0151), of an invention for new and useful improvements in "KEY REPLACEMENT IN A PUBLIC KEY CRYPTOSYSTEM", for which United States Patent Application Serial No. 08/605,427 was filed on February 22, 1996 and will be issued as U.S. Patent No. 5,761,306 on June 2, 1998 (hereinafter the "Invention"); and
- (b) SET Co is desirous of acquiring an interest in the invention and application and in any Letters Patent and Registrations which may be granted on the same.

IT IS AGREED AS FOLLOWS:

1. INTERPRETATION:

In this agreement:

"LICENSED PATENT" means U.S. Patent Application Serial No. 08/605,427, filed on February 22, 1996, including all foreign and domestic counterparts which may issue therefrom, and all divisions, continuations, reissues, substitutes and extensions thereof.

"LICENSED FIELD" means, and is limited to, the practice of the LICENSED PATENTS in the area of enabling key replacements in electronic commerce systems, including electronic commerce systems utilizing smart cards.

2. **VISA GRANT:** For good and valuable consideration, receipt of which is hereby acknowledged by Visa, Visa hereby grants to SET Co an irrevocable, world-wide, sublicenseable, exclusive license to make, have made, use, have used, sell, have sold, offer to sell, import and/or have imported products, systems and devices using the LICENSED PATENT in the LICENSED FIELD.


SETCo, as exclusive licensee, shall have power to institute and prosecute at its own expense suits for infringement of the LICENSED PATENT in the LICENSED FIELD, and, if required by law, Visa will join as party plaintiff in such suits. All expenses in such suits will be borne by SETCo.

3. **SETCO GRANT:** SET Co hereby grants to Visa an irrevocable, sublicenseable, non-exclusive license to make, have made, use, have used, sell, have sold, offer to sell, import and/or have imported products, systems and devices using the LICENSED PATENT in the LICENSED FIELD.

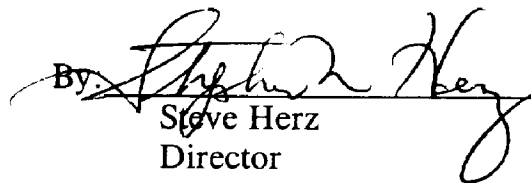
4. **WARRANTY:** Nothing in this agreement shall be construed as a warranty or representation by either party as to the validity or scope of the LICENSED PATENT, or an obligation to bring or prosecute actions or suits against third parties for infringement of any patent.
5. **AMENDMENTS:** Any amendment, waiver or variation of this agreement shall not be binding on the parties unless set out in writing, expressed to amend this agreement and signed by and on behalf of each of the parties.
6. **SEVERABILITY:** The invalidity, illegality, or unenforceability of any of the provisions of this agreement shall not affect the validity, legality, and enforceability of the remaining provisions of this agreement.
7. **WHOLE AGREEMENT:** This agreement contains the whole agreement between the parties relating to the subject matter of this agreement and supersedes all previous agreements between the parties relating to this matter.
8. **GOVERNING LAW:** This agreement is governed by and shall be construed in accordance with California law.


IN WITNESS WHEREOF, the undersigned have duly executed this Agreement as of the date first written above.

Visa International Service Association

By: 
Broox W. Peterson
Senior Vice President,
Assistant General Counsel and
Assistant Secretary

SET Co. LLC

By: 
Steve Herz
Director

By: 
Alan Glass
Director